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REMARKS

This application was originally filed on 28 December 2001 with thirty-two claims, two of which were written in independent form. Claims 21 and 22 were canceled, and Claims 1, 17, and 18 amended on 27 October 2003. Claims 1-17 were amended on 21 January 2005. Claims 1, 5, and 6 were amended on 19 December 2005. Claims 1 and 17 have been amended herein. No claims have been allowed.

The specification was objected to for having a non-descriptive title. The title of the specification has been amended to overcome this objection.

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,552,840 to Ishii *et al.* ("Ishii") in view of U.S. Patent No. 5,612,753 to Poradish *et al.* ("Poradish"). The applicant respectfully disagrees and submits the Examiner has failed to present a prima facie case of obviousness.

Claim 1 has been amended to clarify what is being claimed. Specifically, Claim 1 now recites "a polarizing beam splitter on said illumination path for receiving said filtered beam of light at a first face," and "a total internal reflection prism assembly proximate said first face and on said illumination path and a projection path to separate the illumination and projection paths"

The Examiner has the duty to present a prima facie obviousness rejection. A prima facie obviousness rejection requires more than merely finding each element of the claims in the prior art. "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

The Examiner has not pointed to any teaching in the prior art suggesting the combination proposed by the Examiner. Instead, the Examiner merely states, "It would have been obvious to one of ordinary skill in the art at the time of the invention to use the total internal reflection prism of Poradish *et al.* into the image display system of Ishii *et al.* to provide proper illumination angles while allowing more flexibility in positioning of the element," citing figure 3, and lines

18-19 of column 5 of Poradish.

Referring to Figure 3 of Poradish, the cited passage of Poradish actually states, "As indicated in the figure, for a reflective modulator, a TIR prism 28 is also used in the illumination path to provide the proper illumination angle and to allow the precombined color fields to be imaged by a single projection lens 32." Poradish does not appear to teach "allowing flexibility in positioning the elements" as suggested by the Examiner.

The applicant respectfully submits this is not a suggestion to modify the display system of Ishii to obtain the recited claim elements. As shown in Figure 1 of Ishii, the display system of Ishii includes reflective modulators 12 and 12' that receive illumination light at the proper angle and allow the combined output from the modulators to be imaged by a single projection lens 5. Thus, "add[ing] the total internal reflection prism assembly of Poradish et al. into the image display system of Ishii et al." as suggested by the Examiner does not appear to have any of the benefits suggested by the Examiner as a suggestion to combine. Furthermore, the purported suggestion by Poradish does not appear to be applicable to the display system of Ishii. Ishii shows the illumination beam entering a first face (side by optical source 7) of the polarizing beam splitter 73, and the modulated beams following a projection path C out of the polarizing beam splitter 73. As such, it is unclear on which face of the polarizing beam splitter the total internal reflection prism of Poradish would be placed, or how such a total internal reflection prism would "separate the illumination and projection paths" as recited by Claim 1 as the illumination and projection paths of Ishii are already orthogonal. Without at least a clear indication of how the total internal reflection prism of Poradish could be added to the display system of Ishii to achieve the advantage relied upon by the Examiner, the Examiner's line of reasoning as to why the artisan would have found the claimed invention to have been obvious cannot be considered convincing.

Thus, the Examiner has failed to show an express or implied suggestion in the art to make the combination or modification suggested by the Examiner, and does not provide a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references as required by Ex Parte Clapp. Instead, the Examiner merely appears to have used the applicants own claim as a shopping list to combine

elements from the prior art. Therefore, the Examiner has not met the burden of presenting a prima facie case of obviousness and the rejection under 35 U.S.C. § 103(a) is defective and should be withdrawn.

Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish. The applicant respectfully disagrees. For the reasons given above with respect to Claim 1, the Examiner has failed to present a prima facie case of obviousness of Claim 17 since there is no express or implied suggestion in the prior art references to modify the teachings of the prior art as suggested by the Examiner, nor has the Examiner presented a convincing line or reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the prior art references.

Claims 2, 3, 5-7, 11, 12, 16, 18, 19, 28, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish. Claims 4 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and further in view of U.S. Patent No. 6,285,415 to Brennesholtz. Claims 7 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and further in view of U.S. Patent No. 5,121,983 to Lee. Claims 8-10 and 24-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and further in view of U.S. Patent Publication No. 2003/0020809 to Gibbon *et al.* Claims 13 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and further in view of U.S. Patent No. 6,097,456 to Wang.

Claims 2-16 depend from Claim 1 and should be deemed allowable for that reason and on their own merits. Claims 18-20 and 23-32 depend from Claim 17 and should be deemed allowable for that reason and on their own merits. For the reasons cited above with respect to Claims 1 and 17, the prior art does not show, teach, or suggest the combination of limitations recited by Claims 1 and 17, much less the limitations of Claims 1 and 17 in combination with the additional limitations of the dependent claims.

Additionally, with respect to the combination of Brennesholtz and Ishii and Poradish, the Examiner has failed to either show that the references expressly or impliedly suggest the claimed combination, or present a convincing line of reasoning as to why the artisan would have found

the claimed invention to have been obvious in light of the teachings of the references as required by Clapp. Brennesholtz teaches dividing a white light source into three color components, and shaping the subbands small enough that two or three are present on the panel at the same time. It is far from clear how this advantage is provided by a spiral color wheel as suggested by the Examiner.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that the pending claims are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



Charles A. Brill
Reg. No. 37,786

Texas Instruments Incorporated
PO Box 655474 M/S 3999
Dallas, TX 75265
(972) 917-4379
FAX: (972) 917-4418